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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91223546
Party	Plaintiff Heathkit Company, Inc., Heath Company, Heathkit Vintage LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of U.S. App. Serial No. 86/354,157

For the mark: HEALTHKIT

Published in the *Official Gazette of Trademarks* on Mar. 03, 2015

Class 9 for “computer software used in developing other software applications; application development software”

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Heathkit Company, Inc., Heath Company, and  
Heathkit Vintage LLC

Opposer-Counterclaim Registrant,

Opposition No. 91223546

Apple Inc.,

Applicant-Counterclaim Petitioner.

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United States Patent and Trademark Office  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Arlington, Virginia 22313-1451

**ANSWER TO COUNTERCLAIMS**

Opposer, Heathkit Company, Inc., a Delaware corporation having an address at PO Box 3115, Santa Cruz, CA 95063-3115, Heath Company, a Delaware corporation having an address at PO Box 3115, Santa Cruz, CA 95063-3115, and Heathkit Vintage LLC, a California limited liability company having an address at PO Box 3115, Santa Cruz, CA 95063-3115 (together “Opposer” or “Heathkit” or “Registrant”), hereby answers the numbered paragraphs of the Cancellation Counterclaims filed by Apple Inc. (“Apple” or “Petitioner”) as follows:

**FIRST COUNTERCLAIM FOR  
ABANDONMENT OF REGISTRATION NOS. 2305224, 2325228 and 1218177**

1. Heathkit admits the allegations of the first sentence of this paragraph. Heathkit denies the allegations of the second sentence of this paragraph to the extent that Applicant seeks to allege that the ‘157 Application was filed in class 9 for the now amended goods “computer software used by software developers to develop health and fitness software applications that share health and fitness data with other software applications” when the ‘157 Application in fact was initially filed for “computer software used in developing other software applications; application development software.”

2. Heathkit admits the allegations that it has opposed registration of Applicant/Petitioner’s HEALTHKIT mark on ground of likelihood of confusion and dilution. Heathkit denies that its opposition was filed solely on the basis of “the HEATHKIT and HEATHKIT EDUCATIONAL SYSTEMS marks, as shown in Registration Nos. 2305224, 2325228 and 1218177.” Opposer through itself, its affiliated companies, predecessors-in-interest, and authorized licensees, (also referred to as “Heathkit”), has for over sixty (60) years, been in the business of designing, manufacturing, selling, and distributing a variety of goods and services, including without limitation electronic devices and test equipment in kit form, computers and software in kit form and fully-assembled, and course kits in the field of health and medical. Heathkit’s claims in the Opposition are based on all of its trademarks and service marks for HEATHKIT, whether alone or in conjunction with other words and/or designs, including those that are registered and rights at common law.

3. Heathkit’s registration speaks for itself as to the information and status pertaining to it.

4. Heathkit's registration speaks for itself as to the information and status pertaining to it.

5. Heathkit's registration speaks for itself as to the information and status pertaining to it.

6. Heathkit's registration speaks for itself as to the information and status pertaining to it. Heath Company, a Delaware corporation, acquired the Heathkit assets, including the HEATHKIT Marks and goodwill associated therewith, on February 1, 2013.

7. Heathkit denies the allegations of this paragraph. The Heathkit entity Heath Company, a Delaware corporation, acquired the Heathkit assets, including the HEATHKIT Marks and goodwill associated therewith, on February 1, 2013.

8. The so-called "Defunct Heathkit Entity" has not owned the '224, '228 or '177 Registrations since at least as early as February 1, 2013, and therefore Heathkit denies the allegations of this paragraph that Opposer has not made use in commerce (as that term is defined in Section 45 of the Lanham Act, 15 U.S.C. 1127) of the marks HEATHKIT or HEATHKIT EDUCATIONAL SYSTEMS on any of the goods identified in the '224, '228 or '177 Registrations for the last three years.

9. The so-called "Defunct Heathkit Entity" has not owned the '224, '228 or '177 Registrations since at least as early as February 1, 2013, and therefore Heathkit denies the allegations of this paragraph that the Opposer abandoned the marks and that there is no intent by the Opposer to resume use of the marks.

10. The so-called "Defunct Heathkit Entity" has not owned the '224, '228 or '177 Registrations since February 1, 2013, and therefore Heathkit denies the allegations of this paragraph that the continued presence of the '224, '228 and '177 Registrations on the federal

trademark register is causing injury and damage to Applicant/Petitioner.

**SECOND COUNTERCLAIM FOR FRAUD ON THE USPTO  
CONCERNING REGISTRATION NOS. 919802 and 1218177**

11. Heathkit admits the allegations of the first sentence of this paragraph. Heathkit denies the allegations of the second sentence of this paragraph to the extent that Applicant seeks to allege that the '157 Application was filed in class 9 for the now amended goods “computer software used by software developers to develop health and fitness software applications that share health and fitness data with other software applications” when the '157 Application in fact was initially filed for “computer software used in developing other software applications; application development software.”

12. Heathkit admits the allegations that it has opposed registration of Applicant/Petitioner's HEALTHKIT mark on ground of likelihood of confusion and dilution. Heathkit denies that its opposition was filed solely on the basis of “the HEATHKIT mark, as shown in Registration Nos. 919802 and 1218177.” Opposer through itself, its affiliated companies, predecessors-in-interest, and authorized licensees, (also referred to as “Heathkit”), has for over sixty (60) years, been in the business of designing, manufacturing, selling, and distributing a variety of goods and services, including without limitation electronic devices and test equipment in kit form, computers and software in kit form and fully-assembled, and course kits in the field of health and medical. Heathkit's claims in the Opposition are based on all of its trademarks and service marks for HEATHKIT, whether alone or in conjunction with other words and/or designs, including those that are registered and rights at common law.

13. Heathkit's registration speaks for itself as to the information and status pertaining to it.

14. Heathkit's registration speaks for itself as to the information and status pertaining to it.

15. Heathkit denies the allegations of this paragraph. Heath Company, a Delaware corporation, acquired the Heathkit assets, including the HEATHKIT Marks and goodwill associated therewith, on February 1, 2013. Heath Company is the owner of the '802 and '177 Registrations and has been and is actively using the marks in commerce. Furthermore, Heathkit Company, Inc. is an active Delaware corporation, and Heathkit Vintage LLC is an active California limited liability company, both of which are related to the ongoing business and operations of Heathkit and have been and are actively using the marks in commerce.

16. Heathkit's registration speaks for itself as to the information and status pertaining to it. Heath Company, a Delaware corporation, acquired the Heathkit assets, including the HEATHKIT Marks and goodwill associated therewith, on February 1, 2013.

17. Heathkit denies the allegations of this paragraph. Opposer's Complaint, paragraph one states that Opposer's rights extend from its predecessors in interest, which would include the so-called "Defunct Heathkit Entity." Heath Company, a Delaware corporation, acquired the Heathkit assets, including the HEATHKIT Marks and goodwill associated therewith, on February 1, 2013. Heath Company is the owner of the '802 and '177 Registrations and has been and is actively using the marks in commerce.

18. Heathkit is without knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph, and they are therefore denied. Heathkit admits that the so-called "Defunct Heathkit Entity" was party to a bankruptcy during the summer of 2012.

19. Heathkit is without knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph, and they are therefore denied.

20. Heathkit is without knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph, and they are therefore denied.

21. Heathkit is without knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph, and they are therefore denied.

22. Heathkit is without knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph, and they are therefore denied.

23. Heathkit admits that Donald and Martha Desrochers, filed a Voluntary Petition for Chapter 7 Bankruptcy in the United States District Court for the Northern District of Texas. Heathkit admits that Heathkit Holdings and Subsidiaries Inc. were added as a party to the bankruptcy petition on May 28, 2012. Heathkit is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in this paragraph, and they are therefore denied.

24. Heathkit admits that Applicant's Exhibit B appears to be a copy of a Herald Palladium newspaper that contains a quote from Donald Desrochers, which attributes to him the statements quoted in the twenty fourth numbered paragraph, but denies to extent that the Applicant suggests the statements attributed to Donald Desrochers have any veracity because the assets referred to in the article, including the HEATHKIT Marks and goodwill associated therewith, were by that time subject to a bankruptcy proceeding and beneficially owned by U.S. Bank National Association (the successor of Park National Bank). Apple's Exhibit B states that "a bank now owns what's left of Heathkit." Furthermore, on information and belief, aspects of the Heathkit business continued during this period through authorized distributors and licensees.

25. Heathkit denies the allegations of this paragraph. On information and belief, Heathkit's predecessors in interest, their distributors and/or licensees were offering for sale

and/or selling the items listed in the '802 Registration since before and including March 2012 and after March 2012.

26. Heathkit admits that the Exhibit D appears to be a copy of a declaration of use submitted in connection with the '802 Registration. Heathkit is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in this paragraph, and they are therefore denied.

27. Heathkit admits that the Exhibit D at pages 8-10 appears to be a copy of specimens filed with a declaration of use submitted in connection with the '802 Registration. Heathkit is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in this paragraph, and they are therefore denied.

28. Heathkit is without knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph, and they are therefore denied.

29. Heathkit is without knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph, and they are therefore denied.

30. Heathkit admits that the Exhibit D at page 6 contains this statement. Heathkit is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in this paragraph, and they are therefore denied.

31. Heathkit is without knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph, and they are therefore denied.

32. Heathkit admits that the Exhibit D states that it was submitted on March 7, 2012. Heathkit is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in this paragraph, and they are therefore denied.



33. Heathkit denies the allegations of this paragraph. On information and belief, the so-called “Defunct Heathkit Entity” or its affiliated companies, their distributors and/or licensees were offering to sell or selling the goods listed in the ‘177 Registration upon the signature date of the declaration.

34. Heathkit admits that Exhibit E appears to be a copy of a declaration of use submitted in connection with the ‘177 Registration. Heathkit is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in this paragraph, and they are therefore denied. On information and belief, the so-called “Defunct Heathkit Entity” or its affiliated companies, their distributors and/or licensees were offering to sell or selling the goods listed in the ‘177 Registration upon the signature date of the declaration.

35. Heathkit admits that Exhibit E appears to be a copy of a specimen submitted in connection with the ‘177 Registration. Heathkit admits that Exhibit E recites the Benton Harbor, MI address. Heathkit is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in this paragraph, and they are therefore denied.

36. Heathkit is without knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph, and they are therefore denied.

37. Heathkit denies the allegations of this paragraph. On information and belief, the so-called “Defunct Heathkit Entity” or its affiliated companies, their distributors and/or licensees were offering to sell or selling the goods listed in the ‘177 Registration as of the signature date of the declaration.

38. Heathkit admits that Exhibit E contains this statement. Heathkit is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in this paragraph, and they are therefore denied.

39. Heathkit denies the allegations of this paragraph. On information and belief, the so-called “Defunct Heathkit Entity” or its affiliated companies, their distributors and/or licensees were offering to sell or selling the goods listed in the ‘177 Registration as of the signature date of the declaration.

40. Heathkit denies the allegations of this paragraph. According to Apple’s exhibit, the declaration for the ‘802 Registration was filed on March 7, 2012.

41. Heathkit denies the allegations of this paragraph.

### **AFFIRMATIVE DEFENSES**

On information and belief, Heathkit alleges as follows:

1. Petitioner’s Petition to Cancel fails to state a claim upon which relief may be granted.
2. Petitioner’s request for relief is barred by unclean hands.

**WHEREFORE**, Heathkit prays that the Petitioner take nothing by its Petition against Heathkit, that Judgment be entered against Petitioner with prejudice on each and every count of the Petition, and that the Board award such other and further relief to Heathkit as it deems just and proper.

Respectfully submitted,

Dated: 11/16/2015

By:     /Ted Sabety/      
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*Attorneys for Opposer*

**CERTIFICATE OF SERVICE**

Registrant HEATHKIT COMPANY, INC., HEATH COMPANY, AND HEATHKIT VINTAGE LLC, hereby certifies that a copy of this ANSWER has been served upon Petitioner APPLE INC. on this 16<sup>th</sup> day of November, 2015, by First Class U.S. Mail, postage prepaid, at the following addresses:

Jason A. Cody  
Apple Inc.  
1 Infinite Loop MS:169-3IPL  
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/Ted Sabety/  
Ted Sabety  
Attorney for Registrant